UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,424	04/08/2004	Robert A. De Jonge	GRA01 P-422	8844

277 7590 07/24/2008

PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER	
PILKINGTON, JAMES	

ART UNIT	PAPER NUMBER
3682	

MAIL DATE	DELIVERY MODE
07/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/820,424
Filing Date: April 08, 2004
Appellant(s): DE JONGE ET AL.

Jeffrey S. Kapteyn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 23, 2008 and the claims status amendment of June 5, 2008 appealing from the Office action mailed September 26, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Under section one claim 30 is listed, claim 30 has been canceled as noted prior in the Brief (in SECTION III), 30 should be 29.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0244524	Russell	12-2004
6,679,809	Kato et al.	1-2004
6,059,687	Durieux et al.	5-2000
4,947,967	Kito et al.	8-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23, 26-29, 51-57 and 59, are rejected under 35 U.S.C. 102(e) as being anticipated by Russell, US PGPub 2004/0244524 (filed April 15, 2003).

Re clms 23, 26-29, 51-57 and 59, Russell discloses a shift assembly for controlling the transmission of a motor vehicle comprising:

- a base (22) configured to be mounted to a motor vehicle, including a stop surface (12)
- a shift member/lever (32) movably mounted to said base (22) and being movable to a plurality of discreet positions (park, reverse, drive etc.)

- a shift gate (34) fixed on the shift member (32) and having at least park, reverse and drive gear positions (paragraph 0027), said shift member being movable to input positions corresponding to said transmission control positions (P,R,D, etc.)
- a powered pawl mechanism (54/56) fixed to said base (22)
- said powered pawl having a movable pawl including a first member (58) and a pawl member (54) is resiliently and elastically (everything is elastic as it has some yield) connected to the first member (moves with 58), wherein the pawl member (54) is shiftable between an engaged position wherein said pawl engages a selected one of said gear positions of said shift gate (34) and at least partially restrains movement of the shift member, and a disengaged position wherein said pawl member (54) is disengaged from said shift gate
- said shifter includes a controller that actuates/coupled to said powered pawl based at least in part on at least one vehicle operating parameter (Figure 8, Relay 1 and 2 "other") in addition to an input from a vehicle ignition (120), a position of the shift member (108), and a position of a vehicle brake pedal (128)
- a sensor (any of the switches sense on and off) generates a signal to said controller such that said controller can determine which input position said shift member is in and wherein said controller controls said powered pawl

based upon vehicle operating parameters (see Figure 8) and position of said shift member

- the sensor generates a signal proportional to the distance moved, said controller controls said powered pawl based on signal (switches 108 and 116)
- an input member/movable member (button on shift knob 48, Figure 4, or flow chart character 124), said controller controls said powered pawl based on the number of times said input member is moved during a predetermined time interval
- the movable member (button) comprises a button that translates linearly between two positions (in and out) and wherein the controller controls the pawl based on a position of the movable member
- the controller controls the powered pawl based at least in part on the position of the movable member/lever button (48)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell '524 in view of Kito, USP 4,947,967.

Russell discloses all of the claimed subject matter as described above.

Russell does not disclose a manual release member operably connected to the pawl member when the button is at rest.

Kito teaches a manual release member (33) operably connected to the pawl member for the purpose of providing an override to the solenoid used to hold the pawl in the locked position (C7/L54-C8/L7).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Russell and provide a manual release member operably connected to the pawl member, as taught by Kito, for the purpose of providing an override to the solenoid used to hold the pawl in the locked position.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell '524 in view of Kato, USP 6,679.809.

Russell discloses all of the claimed subject matter as described above.

Russell does not disclose that one of the vehicle operating parameters comprises the engine r.p.m. (speed).

Kato teaches a shift lever assembly wherein an engine revolution speed signal (e) is used to control the shifting of a lever to another gear (C3/L6-C4/L7) for the purpose of preventing careless operation of the shift knob and eliminating the possibility of jack-rabbit starts or hard braking (C3/L36-38).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Russell and provide a shift lever assembly

wherein an engine revolution speed signal is used to control the shifting of a lever to another gear, as taught by Kato, for the purpose of preventing careless operation of the shift knob and eliminating the possibility of jack-rabbit starts or hard braking.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell '524 in view of Durieux, USP 6,059,687.

Russell discloses all of the claimed subject matter as described above.

Russell does not disclose that one of the vehicle operating parameters comprises the vehicle speed.

Durieux teaches a shift lever assembly wherein the vehicle speed is used to control the shifting of a lever to another gear (C4/L21-27) for the purpose of preventing movement of the shift lever into the park position when the car is moving (C4/L21-27).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Russell and provide a shift lever assembly wherein the vehicle speed is used to control the shifting of a lever to another gear, as taught by Durieux, for the purpose of preventing movement of the shift lever into the park position when the car is moving.

(10) Response to Argument

1. Rejection of Claims 23, 26-29, 51-57 and 59 in view of Russell '524

A & E. Claims 23-26, 51-56 and 59

The Appellant argues that Russell does not disclose that the controller actuates the pawl "based at least in part on at least one operating parameter in addition to an input from a vehicle ignition, a position of the shift member, and a position of a vehicle brake pedal."

Independent claims 26 and 51 do not define what this additional operating parameter is. As broadly defined this parameter could be any number of sensors or switches within the vehicle. The "other" within the relays of Russell detects the current operating position judging between park and another position of the transmission. This "other" is not one of the three operating parameters (ignition, position of shifter and pedal) required by the claim which makes this "other" an additional operating parameter used to determine the position of the pawl. Appellant references additional parameters listed in the specification however none of these parameters are listed in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. Claim 27

The Appellant argues that Russell does not disclose that a sensor generates a signal proportional to the distance moved since Russell discloses that the output is the same regardless of the position of the lever.

The Appellant references the specification for additional disclosure of the sensor in the second paragraph of this argument however none of the particulars of the sensor

are found in dependent claim 27. The claim does not define what the proportional relationship between the distance moved and the signal from the sensor. As broadly defined a proportional relationship can be 1:1, this is what Russell discloses. In Russell for every position moved the same signal is generated and delivered the powered pawl. So for every unit, 1, moved in shifting direction a signal unit of 1 is being generated thus the proportional relationship is 1:1 which meets the limitation set forth in claim 27.

C, D & F. Claims 28, 29 and 57

The Appellant argues that Russell does not disclose a lever switch (input member/button) that controls the solenoid "based on the number of times said input member is moved during a predetermined time interval." (claims 28 and 57)

The Appellant references the specification for additional disclose of how the member may be depressed twice to unlock the pawl when the shifter is in select positions. However, these particulars are not found in dependent claims 28 or 57. Dependent claims 28 and 57 only requires a signal "based on the number of times said input member is moved {between first and second positions, clm 57} during a predetermined time interval." The claims do not define what the number of times the input member is moved nor what the predetermined time interval is. As broadly defined a signal movement of the input member during any time can meet this limitation, this is what Russell discloses. Additionally, a user shifting from park to reverse and then to drive also meets this limitation since the input member would have been depressed

twice within a time window and the final generated signal would be to lock the pawl in the drive position.

The Appellant argues that Russell does not disclose that the pawl moves a first distance if the moveable member is depressed once and a second distance if depressed twice in the same time interval. (clm 29)

Again the claim does not define what the time interval is or what the distances moved are. As broadly defined this limitation can occur in any system based on time of the input member depression since there is a response time associated with the solenoid. In Russell if a user depresses the button and release prior to the solenoid reaches full retraction and then depresses the button at any time thereafter and holds the button for a shorter or longer time period then the prior time the distance traveled will be different. The Appellant has not defined the particulars of the arrangement which produces the different distances within the claim since the time interval has not been confined and can be the total time that the vehicle is on.

2 and 3. Rejection of Claim 24 (Russell in view of Kato '809) and Claim 25 (Russell in view of Durieux '687).

The Appellant argues in both instances that Russell does not provide a reason to be modified so that engine RPM and/or vehicle are also operating parameters and any modification to Russell would require additional modifications to the function of the device.

First, Russell, the primary reference, does not need to provide the reason or motivation for a modification. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the required motivation is found in both the teaching references. Re clm 24, Kato teaches using a system which detects the operating parameter of engine RPM to prevent/lock the shifter (C3/L6-C4/L7) for the purpose of preventing careless operation of the shift knob and eliminating the possibility of jack-rabbit starts or hard braking (C3/L36-38). Re clm 25, Durieux teaches using a system which detects vehicle speed to control the shift lever for the purpose of preventing movement of the shift lever into the park position when the car is moving (C4/L21-27). Thus, both Kato and Durieux demonstrate that using engine RPM or vehicle speed as operating parameters of the shifter are well known and one of ordinary skill in the art would indeed be motivated by Kato or Durieux to modify Russell to add an additional operating parameter to better control the locking of the powered pawl.

Second, in response to applicant's argument that such combinations would require additional modification to the function of Russell, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

4. Rejection of Claim 58 (Russell in view of Kito '967).

The Appellant argues that modification of Russell with Kito would require substantial modification of the devices and that simply demonstrating that the parts where known does not render the claim obvious.

In response, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Kito teaches using a manual release mechanism to override the solenoid position as claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James Pilkington

/J. P./

Examiner, Art Unit 3682

Conferees:

Richard Ridley

/Richard WL Ridley/

Supervisory Patent Examiner, Art Unit 3682

Meredith Petravick /mcp/